

REMARKS

File History

In the outstanding Office action of 1/12/2010, the following allowances, rejections, objections, requirements and other actions appear to have been made:

- **Claims 1-7** were allowed. { OA pg. 9, top }
- **Claims 13-14** were indicated to contain allowable subject matter. { OA pg. 9, top }
- **Claims 8-12** were rejected under 35 USC §103(a) as being obvious over **Watanabe** et al (US 2002/0145684)) {= ref #1} as combined with **Sekiguchi** (US 5893621) {= ref #2} and as further combined with **Den Boer** et al (US 6243062). { OA pg. 2, top }

Summary of Current Response

The specification is amended.

Arguments are presented concerning the applied art and its proposed modification.

Brief Overview of Present Application

As seen in application Fig. 1, the display is structured to receive backlighting from a backlighting assembly. See ¶ [0018] reproduced immediately below.

Per application paragraph [0018], there is recognition that backlighting can adversely affect leakage current through the MIM diode when it is supposed to be in an off state. More specifically:

Advantageous Effects

[0018] According to the present invention, since signal lines made of a chemically weak metal are covered and protected by an insulating layer and transparent electrode, the possibility of signal line defects is diminished. **Since a metal layer intercepts light, even though a back light is disposed under** the thin film diode panel, **off current** (Ioff) of the MIM diodes **is not increased**.

[*Emphasis added.*]

In the embodiment of Figs. 8-9, although the floating electrode is made of a light-passing material (e.g., ITO), the opaque electrodes 146, 148 beneath insulating film 152 block light from underneath and thus protect the interfaces from intense backlighting light. A similar light blocking function is better shown in application Fig. 3.

Applicants' Overview of Outstanding Office Action

Watanabe forms the foundation of the outstanding grounds of rejection against Claim 8 and **thus a searching analysis and understanding of Watanabe is required**. (Claim 8 is understood to at least cover the embodiment of application Figs. 8-9.)

Similarly, a searching analysis and understanding of **Sekiguchi** is required.

In terms of a summarizing overview, it is respectfully submitted that the Office action gets its facts wrong, contradicts itself and fails to account for all elements of Claim 8.

Each of **Watanabe** and **Sekiguchi** teaches a floating electrode composed of tantalum (Ta), where the underlying Ta floating electrode is oxidized on a top surface thereof to form an overlying TaO insulating film. Neither of Watanabe and Sekiguchi teaches or suggests a floating electrode made of a light-passing substance and disposed on top. There is a manufacturing reason why the Ta floating electrode of each of Watanabe and Sekiguchi is on the bottom. It is because each of Watanabe and Sekiguchi teaches to oxidize the exposed top surface of the Ta floating electrode.

Applicant submits that Figs. 5 and 6/7 of Watanabe are key to understanding Watanabe in that they are directed to the following:

[0039] FIG. 5 is a drawing showing the steps of a method of **manufacturing** an element substrate of a liquid crystal device according to embodiment 1 of the present invention;

[0040] FIG. 6 is a sectional view showing [[*in parts 6(a)-6(d)*]] the steps **from** the underlying layer forming step [[*Fig. 5(a)*]] **to** the bridge removing step [[*Fig. 5(d)*]] of the manufacturing steps shown in FIG. 5;

[0041] FIG. 7 is a sectional view showing [[*in parts 7(e)-7(g)*]] the steps **from** the second metal film forming step [[*Fig. 5(e)*]] to the pixel electrode forming step [[*Fig. 5(g)*]] of the manufacturing steps shown in FIG. 5;

[Bracketed text and emphasis added.]

More specifically, Applicant submits that reference number 51 of Watanabe is confusingly used to point to many things and that the ordinary artisan would interpret the meaning of reference number 51 as being at times, a specific layer of *multi-layered* structure 51 based on specific context.

Step 5(b)/6(b): In the cross-sectional left side part of Watanabe Fig. 6(b), reference number 51 is pointing to a portion of a continuous pattern 51/62 shown as a top plan view in right side part of Watanabe Fig. 6(b). This first 51/62 pattern is formed on underlying TaO layer 61 and is composed of a first material (e.g., Ta) as described in Watanabe ¶ [0071].

(Note: Layer 61 is described in Watanabe ¶ [0070] as being Ta₂O₅ formed in step 5(a)/6(a))

Step 5(c)/6(c): On the other hand, in Watanabe Fig. 6(c), reference number 51 is pointing to a combination 51/63 that is now fully covered by the TaO insulating films 63 as is expressly described in the following:

[0072] Next, in the insulating film forming step (c) [[*of Figs. 5-6*]], anodization is effected by using the first layers of the scanning lines 51 as anodes **to form anodic oxide films** having a uniform thickness of, for example, 10 nm to 35 nm [[*on the exposed top surfaces of the Ta lines 51*]], and functioning as the insulating films 63 **on the [[now oxidized]] surfaces of the scanning lines 51** and the first metal films 52 [[*sic, should say 62*]]. In this step, the insulating films (second layers) are **formed on the [[exposed Ta]] surfaces of the scanning lines 51**, and the insulating layers 63 are formed for the first TFD [[*Thin Film Diode*]] elements 56a [[*see Fig. 4c*]] and the second TFD elements 56b.

[Bracketed text and emphasis added.]

With the insulating film 63 now covering bump 51 of Fig. 6(c), the first material (e.g., Ta) of step 5(b)/6(b) can no longer clearly function as an electrical continuation of the second metal film (64, Cr) that will be deposited in upcoming step 5(e)-7(e).

Step 5(e)/7(e): More specifically, Watanabe ¶ [0075] describes that second metal deposition step as follows:

[0075] Next, in the second metal film forming step (e) [*of Figs. 5-6,7 and as*] shown in FIG. 7, Cr [*Chromium as the second metal*] is deposited to a uniform thickness, for example, of about 50 nm to 300 nm, by sputtering or the like, and the **third** layers of the scanning lines 51 [*--where the second layer of 51 is TaO insulator and the first is Ta--*], the second metal films 64a of the first TFD elements 56a and the second metal films 64b of the second TFD elements 56b are then formed by the photolithography process. As a result, the TFD elements 56 serving as active elements are formed.

[Bracketed text and emphasis added.]

Based on these teachings of Watanabe, the ordinary artisan would understand that the so-called "third layers" portion of multi-layered structure 51 is formed on insulator 63 and does not directly electrically connect to the underlying first metal layer of Fig. 6(b). In summary, Watanabe teaches forming a Ta base pattern; oxidizing the exposed upper surfaces of the Ta base pattern to thereby fully cover it with TaO and then depositing a different material, Cr on top of the TaO insulating film.

Since it has been demonstrated immediately above that the uppermost layer of item 51 in Fig. 4(c) of Watanabe is not and cannot function as a **"redundant" gate line**, because the Cr is disposed on the TaO insulating film, the outstanding grounds of rejection have been shown to be based on factual error. Moreover, since it has been demonstrated immediately above that item 51 is a multi-layered structure, the outstanding grounds of rejection have been shown to be further based on erroneous fact-finding because they conclude that Watanabe does not disclose 51 as a multi-layered structure.

More specifically, the outstanding grounds of rejection assert as part of their fact-finding:

Watanabe et al disclose (Figs. 4a-4c) a thin film diode array panel comprising:

Claim 8:

- an insulating substrate (20)
- first redundant gate line (51) including a first input electrode (64a) and made of an opaque conductor ...

<cut>

The [[*totality of*]] differences between Watanabe et al and the present invention are [[:]] ... (2) Watanabe et al disclose one-layered gate line [[51]] instead of double-layered gate line; and (3) ...

[Bracketed text and emphasis added, OA pages 2-3.]

Once again, Applicant respectfully submits that item 51 of Watanabe is not and cannot function as a "redundant" gate line and also that item 51 of Watanabe is not a one layered structure but rather a multi-layered structure (although to some extent the Office action is correct in concluding that 51 *functions* as if it were a "one-layered gate line", but that directly contradicts the Office action conclusion that 51 is a "redundant" gate line).

The above identifies at least two clear errors of fact-finding. However, there is also the error that all the differences between Claim 8 and the applied reference (Watanabe) have not been ascertained.

Watanabe does not teach or suggest two redundant gate lines coupled to each pixel-electrode where there is a respective MIM diode provided between each of the two redundant gate lines and the pixel-electrode.

Applicant of course appreciates that den Boer is used for that latter teaching. However, den Boer does not teach or suggest redundant gate lines or the bottom to top structure wherein the floating electrode is on top.

Per Se Obviousness is never Permitted

Applicant of course, also appreciates the Office action argument to the effect that:

However, it has been judicially determined that rearranging parts are at least obvious, *[[where here the Office action is relying on:]]* (MPEP 2144.04 VI.C). *[[And accordingly, in the relevant art,]]* It would have been obvious to one of ordinary skill in the art to form a MIM diode *[[like the Ta/TaO/Cr triple layer one of Watanabe but]]* having the insulating layer formed on *[[top of a lower situated and made-of-Cr plate members forming]]* the first input electrode and the first contact electrode, and *[[to have]]* the floating electrode *[[which in Watanabe is composed of Ta]]* formed on *[[top of]]* the insulating layer *[[where latter is TaO]]*. The result~~[[-ing]]~~ MIM diode with these elements in this order would function *[[by inherency exactly]]* as Watanabe et al's MIM diode. Therefore, it does not patentably distinguish the invention.

[Bracketed text and emphasis added, OA page 4 under copy of Watanabe Fig. 4C.]

However, mere citation of MPEP § 2144.04 VI(C) is not enough even under the generous terms of that PTO-promulgated guideline (not law). As the MPEP section itself cautions, one must make sure the facts are similar and one must be appreciative that mere ability (artisan "could" have) to rearrange parts is also not good enough:

2144.04 Legal Precedent as Source of Supporting Rationale [R-6]

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

VI. REVERSAL, DUPLICATION, OR REARRANGEMENT OF PARTS

C. Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art

must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

[Emphasis added, some parts of MPEP skipped.]

In the present case, Applicant has demonstrated that artisans would appreciate the order of parts in Watanabe to be very significant because the Ta floating electrode must be on the bottom in order to enable oxidation of its exposed upper surface so as to thereby form the TaO insulating film. That is the motivation for doing it in that specific order. There is no motivation shown to exist in the prior art for doing it in the reverse order. This is not "mere" rearrangement of parts.

Additionally, Applicant wishes to point out that per se rules of obviousness are legally impermissible: *Litton Systems v Honeywell* 39 U.S.P.Q.2d 1321 (Fed. Cir. 1996) {"[o]ne must also examine the relevant historical facts and circumstances related to the claimed invention such as commercial success ... **the obviousness inquiry is highly fact-specific and not susceptible to per se rules**" 39 U.S.P.Q.2d at 1325}.

Yet more recently (a few days ago), the PTO's own Board of Appeals has re-iterated as follows:

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention--including all its limitations-- with the teachings of the prior art, **flouts section 103 and the fundamental case law** applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO Examiners and the Board. Indeed, they have been sanctioned by the Board as well. But **reliance on per se rules of obviousness is legally incorrect and must cease**. Any such administrative convenience is simply inconsistent with section 103, which, according to [*Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)] and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. **We once again hold today that our precedents do not establish any rules of obviousness, just as those precedents themselves expressly declined to create such rules**. *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). *Per se* rules used in this manner short circuit the *Graham* inquiry. These rejections, instead of being based on reasoning with rational underpinnings, are based on this *per se* rule. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). In this case, the Examiner has not provided any factual evidence to

show why a person of ordinary skill in the art would have chosen, from a variety of [[materials]], either [[material X or material Y]] to make Greenberg's electrode array body. The Examiner's statement that "PDMS is a very common form of soft silicone used in medical implants" (see Ans. 6) is not supported in the record by underlying factual evidence, and thus can not properly serve as a basis for concluding that it would have been obvious to a person of ordinary skill in the art to specifically use PDMS instead of other types of medical materials to make Greenberg's implantable electrode array body.
[Bracketed text and emphasis added.]

-- **Ex Parte Krulevitch et al** (USPTO Bd. Appeals, 4/7/2010; Appeal 2009-006364, Application 10/115,676), *nonprecedential*.

Sekiguchi also teaches to place Ta floating plate on bottom and Sekiguchi does NOT teach redundant gate lines

Applicant also appreciates the Office action argument to the effect that:

Further, even though Watanabe et al lack disclosure of forming double-layer gate lines, it was well known in the art to form double-layered (or multi-layered) gate lines, **for the benefit of preventing the corrosion**, as evidenced by Sekiguchi (Fig. 1).
[[shown below, but no details given as to what the OA is referring to ...]]

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to form first gate lines at least partially **directly on the first redundant gate lines** for the benefit of preventing the corrosion.

[Bracketed text and emphasis added, OA page 4-5.]

Applicant is at a loss to understand what the outstanding Office action is pointing to in this regard.

Sekiguchi Fig. 1 is a top plan view corresponding to cross section II-II of Fig. 2. In Sekiguchi Fig. 2, element 2 is the floating gate and it is composed of Ta per Sekiguchi col. 9, lines 50-etc. Element 3 is not a gate line but rather serves only as an "anodic oxidation electrode 3" for the manufacturing process that forms the TaO film 8. The Ta common electrode 6 is used during the anodic oxidation process to uniformly form TaO film 8 on top of all the exposed upper surfaces of Ta elements 2, 4 and 3.

In this regard, Applicant is appreciative of the text in Sekiguchi which states: "One end of the anodic oxidation electrode 3 is connected with a common electrode 6, and the other

end with an input terminal 7 for applying signals from an external circuit to the nonlinear resistance elements. The common electrode 6 is used as an electrode for the anodic oxidation process whereby an insulation film 8 is formed on the surface of the lower electrode 2." [Emphasis added.] However the ordinary artisan will readily recognize that the part about 3 being electrically connected to 7 is an error because line 3 will be wholly covered by TaO during the anodic oxidation process. Line 7 is formed of ITO just as are elements 10 and 11 of Fig. 2 and they all reside on top of the insulative TaO film 8. Hence line 3 (of which 4 is an extension) cannot operate as a redundant gate line. Sekiguchi does not teach to the *skilled* artisan, that which is alleged in the Office action.\

Since Sekiguchi also teaches to place the Ta electrodes (including floating electrode 2) on the bottom, the combination of Watanabe and Sekiguchi cannot rationally motivate the skilled artisan to reverse the order, especially because both of Watanabe and Sekiguchi teach to use "the anodic oxidation process whereby an insulation film 8 is formed on the surface of the lower electrode 2." (quoting from Sekiguchi).

While it may be true that de Boer describes in one place: "In accordance with alternative embodiments, a non-metal such as indium-tin-oxide (ITO) may be used as one or both of the electrode(s) 102/103 in the diode of FIG. 19(b). In certain embodiments, the TFD includes ITO as bottom electrode 102 and Mo as top electrode 103 ..."; this does not motivate the skilled artisan to deviate from the teachings of Watanabe and Sekiguchi wherein the floating electrode is on the bottom and is composed of Ta whose upper surface is oxidized to form the TaO insulating film.

With regard to the Office action allegation that Sekiguchi teaches to use the ITO film 8 for preventing corrosion, Applicant has been unable to find such a teaching in Sekiguchi and it is respectfully requested that the PTO point out how that allegation is substantiated.

END NOTES: (These end notes are provided here as additional authoritative support for legal arguments made above. End Note#1 supports the distinction between "teaching" and "disclosing". End Note#2 is directed to the basics of an anticipation rejection. End Note#3 is directed to the requirement for a rational underpinning. End Note#4 is directed to the prohibition against making assumptions.)

More specifically, with regard to End Note#1, the present Office action appears to confuse "disclosing" with "teaching". When an obviousness rejection is made under §103 of US law, it is what a reference (e.g., Sekiguchi) "teaches" when it is read in whole and without aid of hindsight that counts. "Teaching" is not the same as "disclosing". For example if one teaches "Do not think of an elephant"; one is disclosing the idea of thinking about an elephant even though the teaching is in the opposite direction. In this case the Sekiguchi reference "teaches away" from the idea of using line 3 as a redundant gate line because line 3 is wholly covered by the insulating film 8. It is not permissible under US patent law to ignore the "teachings" that an ordinary artisan would glean from the reference and to instead pick and choose from what a reference "discloses" while using Applicant's teachings as road map for reconstructing the claimed invention.

[[End Note #1]]:

When determining whether a claim is obvious, an Examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teachings of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), the Supreme Court noted that "[t]o facilitate review, this [obviousness] analysis should be made explicit."

[[Note this passage extracted from the BPAI decision of Ex Parte 6695510 et al (Ex parte Wyeth) Appeal No. 2009008674, decided 02/04/2010, reported at for example:

<http://dcs.uspto.gov/Foia/ReterivePdf?system=BPAI&fNm=fd2009008674-02-04-2010-1>

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[[End Note #2]]:

A single prior art reference that **discloses**, either *expressly* or *inherently*, each limitation of a claim invalidates that claim by **anticipation**. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. See *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). “Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates.” *Id.* (quoting *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999)).

[[Note this passage extracted from the BPAI decision of Ex Parte Matsubara et al Appeal No. 2009006581, decided 02/10/2010, reported at for example:

<http://dcs.uspto.gov/Foia/ReterivePdf?system=BPAI&fNm=fd2009006581-02-10-2010-1>]]

[[End Note #3]]:

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), **and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.** Such reason must stem from some teaching, suggestion or implication in *the prior art as a whole* or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of

complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ... The examiner may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). ... The mere fact that prior art may be modified in the manner suggested by the Examiner [*to produce the claimed invention*] does not make the modification obvious unless the prior art [*when viewed in whole*] suggested the desirability of the modification. ... One cannot use hindsight reconstruction to pick among isolated disclosures in the prior art to deprecate the claimed invention. ... It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Examiner can satisfy [his/her prima facie] burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

[[End Note #4]]:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017 (CCPA 1967). Further, in rejecting claims as unpatentable on the basis of obviousness, the Examiner must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l. Co. v. Teleflex, Inc., 550 U.S. 398, 418 (2007).

In other words, it is improper to base a conclusion of obviousness upon facts gleaned only through hindsight. "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983)). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Id.* (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138 (Fed. Cir. 1985)).

To support a conclusion that a claim is directed to obvious subject matter, prior art references must suggest expressly or impliedly the claimed invention or an Examiner must present a "convincing line of reasoning" as to why one of ordinary skill in the art would have found the claimed invention to have been obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). When determining whether a rejection based on design choice is appropriate, the Examiner must review the Specification and ascertain if the limitation in question is disclosed

as serving any advantage or particular purpose, or whether it solves a stated [[and thus recognized]] problem. The Examiner also should explain the reasoning used to determine that the prior art would have performed equally as well as the claimed invention. These two steps help present the aforementioned "convincing line of reasoning." Ex parte Clapp, 227 USPQ at 973.

[[Note this passage extracted from the BPAI decision of Ex Parte Rohrer et al Appeal No. 2009001292, decided 02/05/2010, reported at for example:

<http://dcs.uspto.gov/Foia/RetrievePdf?system=BPAI&fNm=fd2009001292-02-05-2010-1>]].

CONCLUSION

It is believed that all outstanding grounds of rejection have been overcome or traversed in light of the foregoing. Applicant respectfully requests entry of the amendment (to the specification) and reexamination with favorable outcome.

Authorization is hereby given to charge any fees due or credit any overpayments in regard to this communication to deposit account 50-5029. If the Examiner has any questions or concerns, a telephone call to the undersigned at (408) 331-1675 is welcomed and encouraged.

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